

REMARKS

Claims 1-4 and 6-28 are pending and stand ready for further action on the merits. Claim 5 has been canceled. Claims 21-28 have been added.

Support for the incorporated matter in Claim 1 and 12 can be found in page 34, lines 12-16 of the original specification of the present application. The phrase "forming a silver image" is supported throughout the specification, particularly the working examples.

The subject matter of canceled Claim 5 is incorporated into Claim 1.

Claims 6 and 8 have been amended so as to depend from claim 1.

Support for the pH range in Claim 21, 25 and 26 can be found in page 111, lines 1-6.

Support for the fillers in Claim 22 can be found in page 11, lines 5-8 and 12-17.

Support for the polyester in Claim 23 can be found in page 12, lines 7-16.

Support for the Young's modulus in Claim 24 and 27 can be found in page 13, lines 13-18.

Support for the phrase "the support is free from fillers" as described in new claim 26 can be found in the implicit description of the "second" invention on page 15, line 1 to page 18, line 15. This description clearly denotes that the filler is in the undercoat layer. It is important to note that of the Examples of the support on page 18, lines 8-15, none of these recite a support containing a filler. As such, the skilled artisan would reasonably conclude that the present inventors were in possession of the subject matter of new claim 26 at the instant priority date.

Support for the group of compounds in Claim 28 can be found in page 17, line 18 to page 18, line 7.

No new matter has been added by way of the above-amendment to the claims.

Prior Art Based Issues

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Majumdar et al. US 6,475,696, Tamagawa US 4,865,941 and Ishigaki et al. US 5,558,979.¹ Applicants respectfully traverse each of the rejections.

¹ It appears to Applicants that the Examiner's comments in sections 3 and 4 on page 2 of the Office Action are reversed. The Examiner's comments regarding Ishigaki et al. appear in section 3 and the Examiner's comments regarding Tamagawa et al. appear in section 4. Applicants' comments in this paper are based under the assumption that the Examiner's comments are reversed.

In describing the requirements for rejection of a claim by anticipation, the Manual of Patent Examining Procedure (Section 2131) states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (ref. omitted). The identical invention must be shown in as complete detail as is contained in the... claim (ref. omitted)."

Accordingly, every element in a claim must be found in the reference in order that the reference anticipates the claim. With this fact in mind, Applicants now discuss each of the cited references and how each of the cited references fail to teach or fairly suggest all of the elements of the claims as amended above.

(1) *Majumdar et al., U.S. Patent No. 6,475,696:*

Majumdar et al. teach "an imaging member comprising an image layer and a support comprising at least one layer comprising an inorganic particle having an aspect ratio of at least 10 to 1, a lateral dimension of between 0.01 μm and 5 μm , and a vertical dimension between 0.5 nm and 10 nm, and polymeric resin", see abstract.

However, Majumdar et al. fail to disclose or suggest all of the elements of the present claims as is required for a rejection under 35 U.S.C. 102(b). Specifically, Majumdar et al. fail to disclose or fairly suggest:

- a) The location of the nucleating agent in Claims 1, 12, 23, 26;
- b) The pH range of the developer in Claims 21, 25 and 26;
- c) The fillers treated with the specific type of onium ion in Claim 22. Ammonium ions are disclosed in column 4, line 8 of Majumdar et al. However, they are not the specific ions in Claim 22 of the present application but NH_4^+ . Also, Majumdar et al. do not describe or suggest the phosphonium ion and sulfonium ion.

d) The polyester comprising a filler treated with an organic onium ion.

e) The instantly claimed support having both a specific Young's modulus range and a filler in Claims 24 and 27. Majumdar et al. utilize a cellulose paper having Young's modulus of 5688 MPa, but it does not contain a filler. Polyethylene layers formed on both sides of the

cellulose paper contain a filler but they have a Young's modulus far lower than the lower limit of the claimed invention of 4400 MPa.

f) The support is free of filler in claim 26. No one skilled in the art would have readily appreciated that the advantageous effects of the claimed invention can be obtained when a filler is incorporated in the undercoat layer only; and

g) The specific compounds in the undercoat layer recited in new claim 28. Majumdar et al. disclose a material having an undercoat layer and state that the undercoat layer may contain a filler. However, Majumdar et al. do not mention or suggest that synthetic polymers such as the resins and materials in Claim 28 can be used as a binder in the undercoat layer.

Since Majumdar et al. fail to teach or suggest any one of items a)-g), Majumdar et al. do not anticipate the claims, and as such, Applicants respectfully request that the rejection over Majumdar et al. be withdrawn.

(2) *Ishigaki et al., U.S. Patent No. 5,558,979:*

Ishigaki et al. teach: "A silver halide photographic material which has an excellent dimensional stability and which is easy in the register operation is disclosed. The silver halide photographic material comprises a support having provided thereon at least one silver halide emulsion layer, wherein the total amount of gelatin in the total hydrophilic colloid layers on the side having said emulsion layer and the total hydrophilic colloid layers on the opposite side thereto is 6 g/m² or less, and the support is a styrene type polymer having a syndiotactic structure." See abstract.

However, Ishigaki et al. fail to disclose or suggest all of the elements of the present claims as is required for a rejection under 35 U.S.C. 102(b). Specifically, Ishigaki et al. fail to disclose or fairly suggest:

h) The incorporation of a filler treated by an organic onium ion into a support as in Claims 1, 12, 22, 23 and 25-28;

i) The incorporation of a clay compound treated with an organic onium ion into an undercoat layer as in claims 1 and 15-18;

j) The pH range of the developer in Claims 21, 25 and 26. Ishigaki et al. use a developer having a high pH (pH of 11.9), see column 26, line 48;

k) The Young's modulus of the support containing a filler in Claims 24 and 27;

l) The polyester support of Claim 23;

m) The specific compounds used in the binder of the undercoat layer of new Claim 28. Ishigaki et al. use gelatin as a binder of the undercoat layer. However, gelatin is not listed in Claim 28.

Since Ishigaki et al. fail to teach or suggest any one of items h)-m), Ishigaki et al. do not anticipate the claims, and as such, Applicants respectfully request that the rejection over Ishigaki et al. be withdrawn.

(3) Tamagawa et al., U.S. Patent No. 4,865,941:

The silver halide photographic light-sensitive material of the present invention forms silver image utilizing silver generated by exposure to light. Tamagawa et al. merely utilize silver halide as a sensor to light and do not utilize silver to form a silver image. In Tamagawa et al., development of the exposed silver halide initiates a polymerization reaction of a microcapsule containing a colorant whereby the colorant in the exposed area is prevented from being transferred to a receiving layer. In the unexposed area, a polymerization reaction does not occur and the colorant is transferred to the receiving layer after destruction of the microcapsule. Thus, Tamagawa et al. do not satisfy the requirement that the material is "for forming a silver image" as recited in Claims 1, 12, 21, 23, 25 and 26.

Furthermore, Tamagawa et al. fail to disclose or suggest other elements of the present claims. As noted above, all elements must be disclosed or fairly suggested to support a rejection under 35 U.S.C. 102(b). Specifically, Tamagawa et al. fail to disclose or fairly suggest:

n) The incorporation of the filler to a layer formed on the support, such as a laminated layer and an undercoat layer as is recited in Claims 12, 23 and 25-28, see column 3, lines 62+ of Tamagawa et al., wherein the filler is taught to be part of the support;

o) The nucleating agent in Claims 1, 12, 23, and 26;

p) The pH of the developer of Claims 21, 25 and 26;

q) A filler treated by an organic onium ion or a clay compound treated with an organic

onium ion as described in Claims 1, 12, 22, 23 and 26-28; and

r) The Young's modulus of the support containing a filler in Claim 24 and 27.

Since Tamagawa et al. fail to teach or suggest any one of items n)-r), Tamagawa et al. do not anticipate the claims, and as such, Applicants respectfully request that the rejection over Tamagawa et al. be withdrawn.

Drawings

Applicants request that the Examiner acknowledges whether the drawings are acceptable.

With the above remarks, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact **Garth M. Dahlen, Ph.D., Esq.** (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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Respectfully submitted,

By Garth M. Dahlen #43575
Marc S. Weiner
Registration No.: 32,181 For
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant